

REMARKS

Applicants have carefully reviewed the Office Action mailed on March 18, 2010. Applicants respectfully traverse (and do not concede) all objections, rejections, adverse statements, and adverse assertions made by the Examiner. Claims 1-5, 8, 10, 12, 17, and 48 are presented for examination.

Claim Rejections Under 35 U.S.C. §112

Claim 1 and 48 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, has possession of the claimed invention. In particular, the Office Action indicated that with respect to claim limitations “which compare the thickness of the first portion waist portion to the first portion cone portion ... Figure 2 only describes the relationship of thickness between the first portion body portion and the first portion cone or waist portion”. We believe that the specification reasonably conveys that Applicants had possession of the claimed invention at the time the application was filed.

As previously indicated, Figure 2 does appear to show the limitations recited in claims 1 and 48. In addition, the specification provides further support for the claimed invention. For example, page 6, lines 27-29 recite that “Fig. 5 shows another embodiment in which inner layer 26 tapers increasingly in thickness from waists 32 and 36 to body portion 30, which includes both the inner layer and outer layer 28.” (emphasis added). This provides additional support for the limitations of claim 1 and 48. Thus, in addition to Figure 2, the specification and Figure 5 both provide further support that reasonably conveys that Applicants had possession of the claimed invention at the time the invention was filed. Applicants respectfully submit that these remarks overcome the rejection.

Claim Rejections Under 35 U.S.C. §103

Claims 1-5, 8, 10, 12, 17 and 48 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ding et al. in U.S. Patent No. 6,364,856. Applicants respectfully traverse the rejection.

Regarding claims 1-5, 8, 10, 12, and 17, claim 1 recites that the first portion [of the balloon] has a greater thickness at the body portion than at the cone portion, and that the first portion has a greater thickness at the cone portion than at the waist portion.

The Office Action apparently admitted that “Ding et al fail to explicitly teach or disclose that the thickness of the waist portion of the first portion is less than the thickness of the body portion of the first portion”. However, the Office Action went on to state that “it would have been obvious to one having ordinary skill in the art to reduce the thickness of the first portion along the waist portion in order to reduce the profile of the balloon.” Applicants respectfully disagree with the assertion that it would have been obvious to adjust the thickness of the device disclosed by Ding et al.

In Figs. 2a and 2b of Ding et al., the porous membrane 13 appears to have a generally uniform thickness along the entire longitudinal extent of the balloon 3, including a portion at its leftmost edge in Figs. 2a and 2b (e.g., a “waist”) where the porous membrane 13 appears to attach to the catheter. Nothing in Ding et al. appears to teach or suggest modifying the device of Ding et al. to be thinner at its waist portion than at its body portion. Indeed, it would seem like the only motivation for such a modification would be Applicants’ specification, which is strictly prohibited as impermissible hindsight.

Furthermore, Applicants disagree with the Examiner’s statement that one would modify the thickness, as described above, “in order to reduce the profile of the balloon” for delivery and removal. Applicants respectfully note that the radial extent of a balloon in its deflated state would seem to be most affected by the thickness at the balloon body portion, which is where most of the bunched-up or rolled-up material of the balloon would be found. In contrast, there is relatively little balloon material at the waist, so that decreasing the thickness at the waist would do little to reduce the radial extent of the balloon for delivery and removal. If anything, one wishing to reduce the profile of the balloon would reduce the thickness at the body portion, compared to the waist, and would not reduce the thickness at the waist compared to the body portion.

In other words, the motivation provided by the Examiner to modify the device of Ding et al. would appear to teach away from modifying the thicknesses in a manner as recited by

claim 1 and, instead, would appear to suggest modifying the device of Ding et al. in a manner far different from what is recited in the claims.

Based on these distinctions, Applicants respectfully submit that independent claim 1 is patentable over the cited art. Because claims 2-5, 8, 10, 12, and 17 depend from claim 1, they are also patentable for the same reasons as claim 1 and because they add significant elements to distinguish them further from the art. Withdrawal of the rejections is respectfully requested.

Regarding claim 48, this claim similarly recites:

wherein the inner layer has a first thickness along the proximal waist;
wherein the inner layer has a second thickness along the proximal cone
portion;
wherein the inner layer has a third thickness along the body portion;
wherein the third thickness is greater than the second thickness; and
wherein the second thickness is greater than the first thickness.

For reasons similar to those discussed above in relation to claim 1, Applicants assert that independent claim 48 is also patentable over the cited art. Withdrawal of the rejections is respectfully requested.

Further examination and withdrawal of the rejections is respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

Date: _____

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